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**Datasheet for the decision  
of 17 December 2009**

**Case Number:** T 1268/08 - 3.5.03

**Application Number:** 01114139.7

**Publication Number:** 1148699

**IPC:** H04M 3/493

**Language of the proceedings:** EN

**Title of invention:**  
Operations control

**Patentee:**  
Ronald A. Katz Technology Licensing, L.P.

**Opponent:**  
Vodafone Group plc

**Headword:**  
Operations control/KATZ

**Relevant legal provisions:**  
EPC Art. 54, 100(c)

**Relevant legal provisions (EPC 1973):**  
-

**Keyword:**  
"Novelty - main request (no)"  
"Added subject-matter - auxiliary requests (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1268/08 - 3.5.03

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.03  
of 17 December 2009

**Appellant:** Ronald A. Katz Technology Licensing, L.P.  
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**Respondent:** Vodafone Group plc  
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**Decision under appeal:** Decision of the opposition division of the  
European Patent Office posted 28 April 2008  
revoking European Patent No. 1148699 pursuant  
to Article 101(2) EPC.

**Composition of the Board:**

**Chairman:** A. S. Clelland  
**Members:** F. van der Voort  
R. Moufang

## Summary of Facts and Submissions

I. This appeal is against the decision of the opposition division revoking European patent No. 1 148 699, which is based on European patent application No. 01114139.7, which is a divisional application of European patent application No. 99101809.4 (publ. No. EP 0 917 335), which is a divisional application of European patent application No. 93110671.0 (publ. No. EP 0 568 114), which is a divisional application of European patent application No. 86904668.0 (published as international application No. WO 87/00375 pursuant to Article 158(1) EPC 1973).

II. The opposition was filed against the patent as a whole and *inter alia* on the grounds that the claimed subject-matter was not new and extended beyond the content of the application as filed or the earlier applications as filed (Article 100(a) and (c) EPC).

In support of its arguments, the opponent referred *inter alia* to the following document:

D1: US 4 071 698 A.

III. In its decision the opposition division held *inter alia* that the subject-matter of claim 1 of a main request, i.e. claim 1 as granted, lacked novelty having regard to the disclosure of D1 (Articles 52(1) and 54 EPC).

IV. The proprietor (appellant) lodged an appeal against the decision. With the statement of grounds of appeal the appellant filed claims of a main request, corresponding to the claims as granted, and auxiliary requests I and

II, and requested that the decision under appeal be reversed and that the patent be maintained on the basis of the claims of the main request or, alternatively, the claims of one of auxiliary requests I and II. Oral proceedings were conditionally requested.

- V. The respondent (opponent) did not file a reply to the statement of grounds of appeal.
- VI. The parties were summoned by the board to oral proceedings. In a communication accompanying the summons the board drew attention to issues to be discussed at the oral proceedings and gave a preliminary opinion *inter alia* on the question of whether or not the subject-matter of the patent extended beyond the content of the great-grandparent application and on the novelty of the subject-matter of claim 1 of the main request having regard to the disclosure of D1.
- VII. In preparation for the oral proceedings the appellant filed with a letter dated 17 November 2009 claims of auxiliary requests III, IV and V and requested that these auxiliary requests be admitted to the proceedings. Further arguments in support of the requests on file were submitted.
- VIII. The respondent informed the board in writing that it would attend the scheduled oral proceedings.
- IX. Oral proceedings were held on 17 December 2009.

In the course of the oral proceedings, the appellant filed claims of a revised auxiliary request I.

The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request) or, in the alternative, that the patent be maintained in amended form on the basis of auxiliary request I as filed at the oral proceedings, auxiliary request II as filed with the statement of grounds of appeal, or one of auxiliary requests III, IV, and V as filed with the letter dated 17 November 2009.

The respondent requested that the appeal be dismissed.

At the end of the oral proceedings the board's decision was announced.

- X. Claim 1 of the main request, i.e. claim 1 as granted, reads as follows:

"A method of operations for a data station (D) to which callers from individual terminals (T1-Tn) are interfaced via a telephone system (C), in which generated voice messages are transmitted to the calling terminals (T1-Tn) via the telephone system (C) prompting the respective callers to transmit signal data to the data station (D) via the telephone system (C), and the signal data transmitted in response to the prompting is received by the data station (D) for use in execution of said operations, characterised in that for at least some of the calls this signal data includes a key number, and that the data station (D) collects signal data of individual callers and verifies that this key number has not been consumed by prior use, thereby qualifying the caller to access certain operations of the data station (D) during the respective call."

Claim 1 of auxiliary request I differs from claim 1 as granted in that, in the preamble, "signal data" is twice replaced by "digital signal data" and in that, in the characterising portion, "a key number" is replaced by "a one-time key number".

Claim 1 of auxiliary request II differs from claim 1 as granted in that, in the characterising portion, "a key number" is replaced by:

"a one-time key number, wherein the key number is provided on a product acquired earlier by the caller".

Claim 1 of auxiliary request III differs from claim 1 as granted in that, in the preamble, "to transmit data" is replaced by "to transmit digital signal data" and in that the following feature is added:

"designations are assigned to callers in response to said transmitted [*sic*] digital signal data; and said designations are stored in relationship with said transmitted digital signal data".

Claim 1 of auxiliary request IV combines the features of claim 1 of auxiliary requests I and III.

Claim 1 of auxiliary request V combines the features of claim 1 of auxiliary requests II and III.

## **Reasons for the Decision**

### 1. *Amendment to a party's case*

1.1 The respondent made no objection to the admission of revised auxiliary request I as filed by the appellant in the course of the oral proceedings and auxiliary requests III to V as filed by the appellant with the letter dated 17 November 2009. Nor did the board see any reason to raise objections of its own motion.

1.2 The board therefore exercised its discretion pursuant to Article 13(1) RPBA to admit these auxiliary requests.

### 2. *Interpretation of claim 1 as granted*

2.1 The board interprets the term "key number" in the context of claim 1 as granted as an access number or code which a caller must provide to the data station in order to be qualified to access certain operations of the data station during the call.

2.2 The feature according to which the key number can be "consumed by prior use" is interpreted by the board as meaning that one and the same key number does not always give access to the operations; it may have become invalid due to a particular use of the number in the past.

### 3. *Main request - novelty*

3.1 Since at the oral proceedings the discussion of the main request focussed on the novelty of the subject-matter of claim 1 having regard to the disclosure of D1, this issue will be considered first.

3.2 Document D1 discloses, using the language of claim 1 as granted, a method of operations for a data station (D1, Fig. 1, data processor 10, switching system 16, audio program repeater 17) to which callers from individual terminals (telephones 14) are interfaced via a telephone system (public telephone system 12, telephone couplers 13), in which generated voice messages are transmitted to the calling terminals via the telephone system prompting the respective callers to transmit signal data (e.g., an account number and phonograph record selection numbers) to the data station via the telephone system (D1, col. 11, lines 18 to 32, and Fig. 4). The signal data transmitted in response to the prompting is received by the data station for use in execution of the operations, in which the data station collects signal data of individual callers (col. 11, lines 39 to 43).

For at least some of the calls, the signal data includes a key number (col. 11, lines 19 to 23, "account number"). On the basis of the account number, the data station checks whether or not the account number is used for the first time. If yes, the caller is qualified to directly proceed to a record selection operation, i.e. to proceed to the record selection operation without intervention by an operator and/or the running of a so-called free-loader algorithm (D1, col. 11, lines 23 to 47). Hence, the data station verifies that the account number has not been consumed by prior use, thereby qualifying the caller to access certain operations of the data station during the respective call.

3.3 The appellant argued that the subject-matter of claim 1 as granted differed from the method disclosed in D1 in that D1 did not disclose the use of a key number which could be



consumed. The term "consumed" had to be understood such that once a key number was consumed, it was no longer existent, similar to the use of a voucher, and, hence, could not be revived or reused at a later point in time for any purpose. An account number as referred to in D1 did not therefore constitute a consumable key number.

- 3.4 In the board's view, however, in the routine illustrated in D1, Fig. 4, the account number provided by the caller constitutes a key number in the sense that it is an access number for accessing the data station in an automatic push-button telephone mode (col. 3, lines 31 and 32, and col. 11, lines 18 to 23).

Further, see point 3.2 above, if the account number has already been used before for accessing the data station, directly accessing the record selection operation is denied. Hence, the account number can no longer be used, i.e. it is consumed, for directly accessing the record selection operation. Whether or not the account number remains existent and can still be used for other operations, even during the same call, or can be used again for the same or a similar operation at a next call, is not relevant to the matter for which protection is sought as defined in claim 1; the claim is concerned with a verification of the key number only in the context of a qualification of the caller to access "certain operations of the data station" and only "during the respective call".

The appellant's arguments are therefore not convincing.

3.5 The board thus concludes that the subject-matter of claim 1 as granted is not novel having regard to the disclosure of D1 (Articles 52(1) and 54 EPC).

3.6 The main request is therefore not allowable and, consequently, it has not proved necessary to consider any further possible objections, e.g. as referred to in the communication accompanying the summons to oral proceedings.

4. *Auxiliary requests - added subject-matter*

4.1 The great-grandparent application, i.e. European patent application No. 86904668.0, published as international application No. WO 87/00375, includes only one method claim, namely claim 17, which reads as follows:

"A method of analysis in which calls from a multiplicity of terminals of a communication system are received at a receiving station, automated response to each call is made from the receiving station to the calling terminal prompting the caller to transmit digital-signal data representative of identification information to the receiving station via the communications medium of the system, and digital-signal data transmitted via the communications medium by the caller in response to the prompting is received at the receiving station, characterised in that the method includes machine assignment at the receiving station of individual designations to the respective callers in response to reception from them of their identifying digital-signal data, prompting each caller to transmit digital-signal data representative of statistical information to the receiving station via the communications medium,

receiving any such digital-signal data transmitted by each individual caller and storing the statistical data represented thereby in relationship with the identification data received from, and designation assigned to, that caller, carrying out [sic] a process to relate the statistical data stored in respect of the different callers to a criterion for selection, and selecting the identification data and designations assigned thereto, of callers from whom the stored statistical data meets said criterion as determined by said [sic] process."

4.2 Claim 1 of auxiliary request I does not include at least the following features of the above claim 17:

i) machine assignment at the receiving station of individual designations to the respective callers in response to reception from them of their identifying digital-signal data;

ii) carrying out a process to relate the statistical data stored in respect of the different callers to a criterion for selection; and

iii) selecting the identification data and designations assigned thereto of callers from whom the stored statistical data meets said criterion as determined by the process.

These features are concerned with the processing of data provided by the callers. Individual designations are assigned to respective callers and data of certain callers is selected on the basis of a certain criterion.

4.3 The appellant argued that the great-grandparent application provided a basis for the omission of these features. More specifically, claim 9 of the great-grandparent application, which was directed to a control system, implied a control method which was not limited to the processing of statistical analysis or any other method of analysis. Further, the assignment of designations was part of a data processing after the caller was qualified and was therefore irrelevant to the claimed aspect of the invention which dealt with granting access to the operations by verifying a key number.

4.4 The board does not find these arguments convincing for the following reasons:

Claim 9 of the great-grandparent application reads as follows:

"A control system for use with a communication facility including terminal apparatus for individual callers, said control system comprising:

means coupled to said communication facility to interface said terminal apparatus for language and digital communication;

language organization means for prompting a caller at a terminal apparatus active to provide digital signal data representative of identification and caller information;

means for assigning unique designations to callers in response to said identification and caller data;

record means for storing said unique designations in relationship with said identification and caller data for specific callers; and

processing means for receiving said caller data to process said caller data in relation to select operations."

Claim 9, similar to above-quoted claim 17, therefore includes features relating to the processing of the data provided by the callers, namely the assignment of "unique designations to callers in response to said identification and caller data" and the processing of the "caller data in relation to select operations".

Further, even if, as argued by the appellant, the assignment of designations is part of a data processing which takes place only after the caller is qualified, this, in itself, does not imply that the assignment feature can be omitted from the claim; a basis in the great-grandparent application for directing the claim to the aspect of qualification only is required, in the absence of which the subject-matter of the patent extends beyond the content of the great-grandparent application.

In support of its arguments the appellant also referred to page 2, lines 14 to 23, and page 15, lines 15 to 21, of the great-grandparent application, in which the invention is described in more general terms.

However, each of these passages explicitly refers to the data processing as part of the invention: "In general, the present invention comprises an analysis and selection system ..."; "A control system may qualify a caller then provide data cells for storing individual data and assigning definitive identifications to such data (and to the caller) and subsequently testing such

data as for the selection of a subset of callers"; and "... data is assembled, stored, identified, processed by testing to isolate a subset or manifest data with sources reliably confirmed".

The board further notes that the above-mentioned data processing features are also to be found in the remaining independent claim of the great-grandparent application, i.e. claim 1: "means for assigning designations to callers in response to said identification and statistical data" and "correlating said established data with said statistical data to isolate select identification data for select [sic] of said callers".

- 4.5 The above considerations apply *mutatis mutandis* to claim 1 of auxiliary request II and, at least as far as feature iii) referred to at point 4.2 above is concerned, to claim 1 of each one of auxiliary requests III to V (see point X above).
- 4.6 The board therefore concludes that the ground for opposition pursuant to Article 100(c) EPC prejudices the maintenance of the patent in view of the subject-matter of claim 1 of each of the auxiliary requests I to V.
5. Since none of the appellant's requests is allowable, the appeal is to be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland